

Remarks

Applicant has carefully reviewed the grounds for rejection under 35USC 103 which are hereby traversed.

As indicated in a brief telephone conference kindly provided by the Examiner, The Examiner has cited a passage in PPG, 156 F.3rd 1351 at 1355 allegedly defining the meaning of "consisting essentially of". Notwithstanding the use of this passage at MPEP2111.03, this citation is not appropriate, The PPG case relates to an alleged infringement of its claim. The validity of the claim is not in issue in this case. The only question was whether the language of the claim protected PPG' property right in the allegedly infringing product, namely whether a component in the defendants product had a "material effect".

The court, at 1354 discusses the definition of "consisting essentially of". It stated that this term lies between "consisting of", which is a closed term meaning that nothing else may be present and "comprising" which means that the listed components must be there but anything else may also be there. The characteristic of "consisting essentially of" was that while additional components could be added, the claim could be infringed by the presence of additional components provided they did not have a "material effect". The court in PPG agreed with the trial court that the iron sulfide in question did have a material effect; hence the claim was not infringed. The gist of the passage cited by the examiner was that PPG could have included iron sulfide in the claim if it wish to, and this might have caused the defendant's product to infringe the claim. The court did not hold that the claim was invalid or indefinite because it did not include iron sulfide merely that it was not infringed.

Hence the examiners position that applicant needs to specify what is excluded, must be specified is in error. The law is clear, substances which do not have a material effect does not have to be recited. In this particular case additives which do not have a material effect are those which do not affect applicant's novel solubility techniques such as, for example, colorants, odorants and flavorants.

In view of the foregoing argument, it is clear that all of the Examiner's other arguments fail, and prompt passage to issue is solicited.

The present amendment was occasioned by a close study of the claims and the cited art in preparation for filing a Brief on Appeal. At that time it was noted that there were errors in claims 29 and 30. The Examiner did not appear to notice them, however if this case is going on appeal, a proper set of claims should be presented to the Board. Thus both claims are now recited as "consisting essentially of" to bring them in line with the claim 25 et seq. Furthermore it was noted that claim 29 should have recited dependency on claim 25 not claim 1.

In the event that the Examiner declines to withdraw the rejections and issue the case, it is respectfully requested that the foregoing amendments be entered for purposes of appeal since they do not alter the general intent of the claims.

Respectfully submitted

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